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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/042,032	10/25/2001	Hiroyuki Okahira	980615CD/LH	5742

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EXAMINER

NGUYEN, TU T

ART UNIT	PAPER NUMBER
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2877

DATE MAILED: 09/11/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/042,032

Applicant(s)

OKAHIRA ET AL.

Examiner

Tu T Nguyen

Art Unit

2877

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 21-27 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 21-27 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☒ Certified copies of the priority documents have been received in Application No. 09/158,362.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s) ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

Detailed Office Action

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 21-27 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

With respect to claim 21, the term “said observation unit supporting section being movable along side edges of the substrate holder” is not clear. As stated in line 4, the observation unit supporting section is a horizontal member 14 (fig 1); how the bar 14 (fig 1) can be moved? Does Applicant mean the head 9 or 6 (fig 1) move horizontally on the observation unit supporting section? For the examination purpose, Examiner assumes the observation unit supporting section is the horizontal bar 14 (fig 1) and the observation unit 9 (fig 1) is movable along the horizontal bar 14 (fig 1).

With respect to claims 22-27, the claims 22-27 would have also been rejected as being depended on claim 21.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321[©] may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 21-27 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-13 of U.S. Patent No. 6,362,884. Although the conflicting claims are not identical, they are not patentably distinct from each other because most of the claimed limitations in the claims 22-27 in this application have been disclosed by claims 1-13 in the Patent No. 6,362,884. The limitations which are not disclosed such as: glass substrate; hollow frame; display device, would have been well known in the art.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 21-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kazu (JP 04-095913).

With respect to claim 21, Kazu discloses a visual observation unit. The unit comprises: a substrate holder 22 (fig 1), an observation unit supporting section 8 (fig 1) that extends across the substrate holder, a support columns that support the horizontal member (fig 1), a micro observation unit 7 (fig 1) is movable in a direction in which the observation unit supporting section extends (abstract).

Kazu does not explicitly disclose scanning the surface. Since Kazu discloses a movable observation unit 7 (fig 1). It would have been obvious to use Kazu's system to scan the test surface to test the entire surface for defects.

With respect to claim 22, Kazu does not explicitly disclose testing a glass substrate. Since Kazu discloses testing a flat surface 5 (fig 1). It would have been obvious to modify Kazu's system to test surface from different material without changing the setup. It would save time and cost.

Kazu does not disclose a vacuum chuck for holding the substrate. However, using a

vacuum to hold a substrate would have been known. It would have been obvious to implement a known vacuum chuck to Kazu's system to hold the substrate better.

With respect to claim 23, Kazu does not explicitly disclose the inspection microscope comprising an objective lens and an ocular lens. However, the microscope comprises an objective lens and an ocular lens would have been inherent.

Claim 24 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kazu (JP 04-095913) in view of Worster et al (5,479,252).

With respect to claim 24, Kazu does not disclose a camera, an image display. Worster discloses an image display 215 (fig 2), camera 212, 219 (fig 2) for detecting a surface. It would have been obvious to combine Kazu with Worster's imaging system to detect the surface faster.

Claim 25 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kazu (JP 04-095913) in view of Ozeki (4,836,667).

With respect to claim 25, Kazu does not disclose a linear light arranged at a lower than the substrate holder. Ozeki discloses a light source 11 (fig 1b) arranged under the substrate holder 18 (fig 1a). It would have been obvious to modify Kazu with Ozeki's light source to light up the test surface which make the system more accurate.

Claims 26-27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kazu (JP

04-095913) in view of Naoshi (JP 05-322783).

With respect to claims 26-27, Kazu does not disclose a guide scale and the position coordinator. Naoshi discloses a coordinate display with a scale position (paragraph [0008], page 1). Naoshi does not disclose the specific guide scales as claimed. Since Naoshi keep track of the coordinate position with a scale position, it would have been obvious a matter of a design choice to modify Naoshi's system with a different type of guide scales to meet the system requirement. The modification involves only routine skill in the art.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tu T Nguyen whose telephone number is (703) 306-9185. The examiner can normally be reached on M-T 7:30-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Frank G Font can be reached on (703) 308-4881. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 308-7722 for regular communications and (703) 308-7722 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0956.



Tu Tuan Nguyen
Patent Examiner TC 2877
September 06, 2002/TTN